

REMARKS

Claims 1-12 are pending and under consideration. Claims 1, 4 and 9 are the independent claims.

Claims 1, 3, 4 and 9 have been amended.

No new matter is believed to have been added.

REJECTION UNDER 35 USC §112

Claim 3 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

It is respectfully submitted, that the amendments to claim 3 overcome the rejection.

DOUBLE PATENTING REJECTION

Claims 1-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of US Patent No. 6,694,091 and claims 1-12 of US Patent No. 6,813,281.

Since claims 1-12 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claims would be premature. MPEP 804(I)(B). As such, it is respectfully requested that the applicant be allowed to address any obviousness-type double patenting issues remaining once the rejections of the claims under 35 U.S.C. §112 and §103 are resolved and that the rejection be reconsidered in light of the amendments and claims presented above.

REJECTION UNDER 35 USC §103(a)

In the Office Action at pages 9-16, the Examiner rejects claims 1-12 under 35 U.S.C. §103(a) in view of Oguro (EP 0682421) and Endoh et al. (U.S. Patent No. 6,016,295). The rejections are respectfully traversed and reconsideration is requested.

Amended claim 1 recites "(a) when one of the programs is changed to another one of the

programs, searching whether there is a sub-audio data stream having a channel ID which is the same as a user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed, in the another program; and (b) when it is determined that there is the sub-audio data stream having a channel ID which is the same as the user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed in the step (a), selecting the sub-audio data stream having the same channel ID of the another program."

Amended claim 4 recites "reproducing one of the dual mono channels of one of the audio data streams of a first one of the programs according to a user selection; changing to a second one of the programs; and determining if one of the dual mono channels of one of the audio data streams of the second program corresponds to the one dual mono channel of the one audio data stream of the first program, and reproducing the one dual mono channel of the one audio stream of the second program if the correspondence exists."

Amended claim 9 recites that "when a first one of the programs is changed to a second one of the programs, searching whether there is a second dual mono channel of the second program having a channel ID which is the same as a channel ID assigned to a first dual mono channel selected by a user of the first program which was being reproduced prior to the change; and selecting the second dual mono channel if the search is successful."

As a general matter, in order to establish a *prima facie* obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. Both the individual elements and the motivation need to be shown to have existed in the prior art. Should the Examiner fail to provide evidence that either one of the individual elements or the motivation does not exist in the prior art, then the Examiner has not provided sufficient evidence to maintain a *prima facie* obviousness rejection of the claim. MPEP 2143.03. Thus, the burden is initially on the Examiner to provide evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art. MPEP 2143.01.

Oguro discloses "a multilingual indication that is generated when at least two of the audio channels of a digital audio signal are associated with a **common program**. (See Oguro Abstract) (Emphasis added). Thus, Oguro teaches that when multiple languages are associated with a single program, an indication is given to the user. The Action relies on FIGs. 33-36 to show the searching function recited in the claims; however this misinterprets the teachings of

Oguro. The multilingual indicator flag ML is simply used to indicate that a program has been recorded in more than one language so that a user can pick which language to reproduce. (See Oguro page 14, lines 24-26). Oguro illustrates in, for example, FIG. 34C that a first program (i.e., movie) was recorded multilingually and that a second program was recorded multilingually (i.e., news). However, there is no teaching in Oguro that there is any connection between the separate programs, and there is no teaching that any search function is performed. The ML flag simply indicates that each of the first and second programs is recorded in more than one language. (See Oguro page 15, lines 10-11). The ML flag is an indicator and nothing more, there is no teaching or suggestion in Oguro that searching is associated with the ML flag.

Further, there is nothing in Oguro that teaches that a channel selection of the second program has any nexus to the channel selection of the first program, as recited in each of the independent claims of the present invention. Thus, Oguro does not teach or suggest that a search is made when switching from a first to a second program and that a channel is selected based on the search finding a matching channel between the first and second programs as recited in each of the independent claims. (e.g., claim 9 recites, *inter alia*, "when a first one of the programs is changed to a second one of the programs, searching whether there is a second dual mono channel of the second program having a channel ID which is the same as a channel ID assigned to a first dual mono channel selected by a user of the first program which was being reproduced prior to the change; and selecting the second dual mono channel if the search is successful").

Endoh does not cure the deficiencies of Oguro. Endoh discloses a karaoke reproduction machine which determines the surround mode and special use mode of the audio stream. (See Endoh Abstract). However, Endoh, like Oguro, does not teach or suggest any connection between separate programs. The Action relies on a comparison that Endoh performs with a default language code setting of the reproducing apparatus as being the previous channel ID of the previous program. In contrast, the amended claims of the present invention recite that a user selects the channel ID of the first or previous program and that the channel ID of the second program is selected based on a search for a channel ID that matches the user selected channel of the first program. Endoh is simply matching a language code of the disc with the default setting of the reproducing apparatus (i.e., the karaoke machine). (See Endoh col.32, lines 53-58).

As commonly understood, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of

ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

There is no teaching or suggestion in either Oguro or Endoh to make any combination of the references. Oguro is using a flag indicator to indicate to a user that a program is recorded in more than one language. Endoh searches a program that is recorded in more than one language for a match to a default of the reproducing machine. To set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966). However, in the instant case, no such evidence has been presented. Rather, conclusory statements are made that do no indicate any motivation why someone skilled in the art would take the flag indicator teachings from Oguro and combine them with the default language selection of Endoh.

Even assuming you could combine Oguro and Endoh, the combination would result in a flag indicating to the karaoke machine that multiple languages were used for the program on the disc rather than the present invention. There is no teaching or suggestion in either of the cited references that changing from one program to another causes a search for a matching channel ID and selection of the matching channel ID as recited in each of the independent claims. (See for example, "**when one of the programs is changed to another one of the programs, searching** whether there is a sub-audio data stream having a channel ID which is the same as a user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed, in the another program; and (b) when it is determined that there is the sub-audio data stream having a channel ID which is the same as the user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed in the step (a), **selecting the sub-audio data stream having the same channel ID of the another program.**") (Emphasis added). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

It is respectfully submitted that Oguro, either alone or in any proper combination with Endoh does not teach or suggest all of the limitations of independent claims 1, 4 and 9. Further, dependent claims 2-3, 5-8, and 10-12 are patentable over the references of record for at least the same reasons as their respective base claims, as well as for any additional features they recite.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 10/11/05

By: 
Michael D. Stein
Registration No. 37,240

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9505